

The Examiner's rejection of claims 1-5 under 35 U.S.C. §103 as allegedly being made "obvious" based on Peters '284 in view of Hogan '528 is once again respectfully traversed.

The remarks supporting such traversal already provided in applicant's amendment of May 11, 2007 are here again expressly incorporated by reference. All of such arguments are still believed to be applicable. Discussion of particular arguments addressed by the Examiner's "Response to Arguments" section will be provided below.

With respect to applicant's earlier argument that Peters does not mention "editing a bill image", the Examiner finds that argument not persuasive because of the Peters teaching at column 29, lines 3-17. The Examiner states that applicant's argument is "not persuasive" because this section of Peters, in the Examiner's view, "correspond[s] to applicant's argument". Indeed, it does "correspond" to applicant's argument because it nowhere teaches any kind of editing of a bill image. The entirety of this passage is quoted below for convenience to demonstrate that irrefutable fact:

Upon indication of a billing generation requirement for a particular subscriber, the present invention accesses the database for that subscriber, collects current unbilled usage data for billing (including regular monthly fees, pay-for-view fees, and equipment and maintenance charges), historical information (such as balances forwarded and recent payments yet to be credited), and any other information to be included on the bill (such as announcements and advertising). The invention then prepares a bill for the subscriber on a standard format. The bill images are sent to a printing house where they are printed, placed in individual envelopes, and mailed to each subscriber. Then, the system's databases are updated

accordingly (particularly regarding indications of what has been billed and is now an account receivable).

It will be noted while this passage does teach the creation of a bill image, there is nothing in this passage about thereafter editing the appearance of such a bill image.

With respect to applicant's earlier argument that Peters does not describe assignment of charge type identifiers (CTI) to records appearing in a bill image, the Examiner first alleges that he did not earlier rely upon Peters for this alleged teaching but, instead, upon Hogan at Figures 3 and 9 and at column 10, lines 1-30.

Initially, it is noted that the Examiner's last Office Action, at page 2, did in fact allege that Peters taught assignment of a charge type identifier (CTI) "stored in the computer implemented billing system". Reference was then made to Peters at 17:39-67 to 18:23.

In any event, it appears from the Examiner's latest comments that the Examiner agrees that such teaching is not found in Peters.

Now the Examiner apparently relies upon the above noted portions of Hogan for teaching of a CTI. However, as already noted in earlier remarks, Hogan is directed towards electronic bill payment and also not at all towards editing the bill image -- nor using charge type identifiers to facilitate such editing. Consistent with this Hogan teaching, Figure 3 merely provides a screen which permits the user/bill payer to select as one option at block 203 "receive and pay bills". Other options on this screen permit the user to select new payees, to update the electronic account register and to review

payments earlier made. It is also possible to obtain an account balance and to seek “help”. There is nothing here about assignment of a “charge type identifier” to records appearing in a bill image.

Similarly, Figure 9 simply provides a menu of user options including “view and/or pay bills”; “view payment confirmation”; “view administrative messages”; and “exit”. There is nothing in Figure 9 about assignment of a CTI to records appearing in a bill image.

Similarly, the entirety of the text cited by the Examiner is quoted below to demonstrate that this portion of Hogan is also similarly deficient:

Utilizing a standard receipt confirmation feature of the e-mail service, server computer 160 would receive an acknowledgement message through network 110 when the electronic bill is received and opened by the subscriber. This acknowledgement message includes a time stamp indicating the date and time when the electronic bill was opened, the subscriber's e-mail address indicating where the acknowledgement comes from and the information in the “subject” field of the electronic bill, which identifies the bill by including the payee's name, bill amount and payment due date. In accordance with another aspect of the invention, the EBSC is alerted by computer 160 to those electronic bills whose acknowledgement messages have not been received before their respective due dates. The alert may take the form of a daily print-out of the outstanding bills from computer 160. Upon reading the print-out, in order to avoid overdue payments, the EBSC will attempt to inform the subscriber of his/her outstanding bills by other means of communications such as regular mail.

In operation, upon invocation the electronic bill payment program first checks for any electronic bills unopened by the subscriber, as indicated at step 801 in FIG. 8A,. This is done

by reading the open status bits of all the electronic bills saved including the newly arrived bills. If any unopened bill is detected, the program at step 803 causes display 107 to exhibit an announcement such as "YOU HAVE UNOPENED BILLS!" to alert the subscriber to read the bills. In either event, the program proceeds to step 805 where the pay status bits of all the previously opened bills are checked to see whether they have been paid. If unpaid bills are detected, the program at step 807 causes display 107 to exhibit another announcement such as "YOU HAVE UNPAID BILLS!" to alert the subscribers that not all the opened bills have been paid. In either event, the program proceeds to step 809 where it causes display 107 to exhibit menu 901 as shown in FIG. 9.

Perhaps even more importantly, Hogan has nothing at all to do with editing the appearance of a bill image. As previously explained, Hogan has only to do with providing an ability to pay a presented bill electronically. The image of the bill presented to the user/payer (if any) is controlled elsewhere. The payer of the bill does not have the ability to edit the appearance of the bill. Should the Examiner find some teaching to the contrary in either of the cited references, then the Examiner is specifically requested to point out exactly where there is such a teaching or suggestion.

With respect to applicant's argument that Hogan fails to disclose how an individual payee edits or even generates a bill image, the Examiner asserts that such a feature is found in Hogan at column 7, lines 27-65. However, the undersigned has been unable to find any such teaching or suggestion at this (or any other) portion of Hogan. For convenience, the entirety of the text cited by the Examiner is quoted below to demonstrate the fact that there is no such teaching here:

At step 314, if “Update Electronic Account Register” choice 207 is selected, server computer 160 retrieves confirmed payment data and causes an update, taking into account the confirmed payments, to an electronic account register provided by the subscriber’s financial management software of the type of QUICKEN, MICROSOFT MONEY or MANAGING YOUR MONEY preloaded on PC 100. Server computer 60 also causes the software to show the updated register on display 107, as indicated at step 394.

If “Review Payments” choice 211 is selected at step 314, server computer 160 retrieves the confirmed payment data, and the payment records created at step 378 described above, and causes display 107 to show records of payment with indications of “confirmed” status for those payments which were confirmed, as indicated at step 393.

If “Help” choice 209 is selected at step 314, server computer 160 causes display 107 to present a description of the electronic bill payment service including current service functions, rules and procedures, etc., as indicated at step 395.

If “Select New Payees” choice 205 is selected at step 314, server computer 160 causes display 107 to list all the payees previously identified by the subscriber, and enables the subscriber to add new payees to or delete selected payees from the list, as indicated at step 399. Upon learning the changes in the payee list, he personnel of the EBSC accordingly establishes or cancels the electronic bill payment service with the corresponding payees.

As will be appreciated, this section of Hogan gives the user/bill payer several options in the payment of bills but does not teach or suggest any capability for the individual payee to edit or generate a bill image. In particular, any bill image displayed to the payee was earlier generated in some undisclosed process by the vendor whose bill

is being paid. The payee would not appear to have any option to change that bill when making payment.

With respect to applicant's argument that since neither Peters nor Hogan describes a method of editing a bill image, nor any other method involving any of the steps set out in the independent claims, the presently claimed invention could not possibly be anticipated or rendered obvious in view of any teaching of these documents whether considered alone or in combination, the Examiner presents an extensive section of text bridging pages 5-7 which appears to have been generated with respect to a different case. For example, the Examiner refers to an alleged mis-interpretation by applicant of some of the case law cited. However, applicant's earlier argument does not cite any case law.

The applicant agrees that obviousness must be determined on the basis of the evidence as a whole. Of course, the relative persuasiveness of arguments is to be considered.

However, using such a standard, the Examiner clearly has not yet presented a *prima facie* case of obviousness since he has not presented evidence of corresponding claim elements in the prior art. Nor has the Examiner expressly articulated the "combinations and the motivations for combinations that fairly suggest applicant's claimed invention". In the context of cited prior art that fails to teach any of the claimed features, it is hard to understand how one of only ordinary skill in the art would ever have found it "obvious" to make any combination of the features that are actually disclosed in either of these two references and, in any event, even if all the features of both references

are somehow “combined”, they still necessarily fail in that combination to teach or suggest applicant’s claimed features.

The Examiner argues that the outstanding grounds of rejection combining alleged features of these references is “based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention”. However, how can logic and scientific reasoning create something out of whole cloth? Unless the claimed features of applicant’s invention can be found in at least one of the cited references, there is no “logic and scientific reasoning” available (at least to the best of the undersigned’s understanding) that would permit the combination of these references to somehow magically cause such features to appear for the first time.

The undersigned agrees with the Examiner’s quotation from prior case law to the effect that “[the Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” For reasons already noted, it is respectfully submitted that the Examiner in this particular case has not yet satisfied this agreed upon burden. That is, so far as the undersigned can ascertain, there is no objective teaching in the cited prior art of the claimed features of the applicant’s invention -- let alone any knowledge to be gleaned from the four corners of these documents (even if combined) that would demonstrate knowledge generally available to one of ordinary skill in the art that would lead that individual to combine “relevant teachings” of the references.

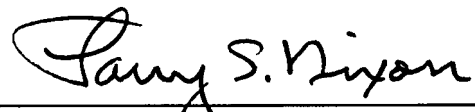
The Examiner alleges, to the contrary, that all modifications proposed by the Examiner are "specifically taught by the references". However, as the undersigned has attempted to point out repeatedly, the Examiner's allegations are not supported by the portions of these references referred to by the Examiner. Furthermore, the undersigned has studied the entirety of these references and fails to find anywhere in these references the features the Examiner alleges to find. If there are specific and explicit teachings as alleged by the Examiner in either of these references, then it is respectfully requested that those teachings be specifically noted.

Where, for example, do either of these references even teach the broad concept of editing a bill image -- let alone based on charge type identifiers or the like?

It is hoped that in light of the above further discussion the Examiner will reconsider applicant's earlier presented arguments and find them persuasive. A Notice of Allowance is respectfully solicited.

Respectfully submitted,

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